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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,223	12/21/2004	Georg Gros	DNAG-293	2138
24972 7590 03/17/2009 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198				
EXAMINER				
VDAYAKUMAR, KALLAMBELLA M				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
03/17/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/511,223

**Applicant(s)**

GROS, GEORG

**Examiner**

KALLAMBELLA  
VIJAYAKUMAR

**Art Unit**

1793

**—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —**

THE REPLY FILED 02 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
b) ☐ They raise the issue of new matter (see NOTE below);  
c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 141-177.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: See Continuation Sheet.

/Stanley Silverman/  
Supervisory Patent Examiner, Art Unit 1793

Continuation of 11. does NOT place the application in condition for allowance because:

The claims as amended do not overcome the rejection of claims under 35 USC 112-II-Para for the following reasons:

The claims as amended contain the filler (A) comprising filler (a) in an amount of 0.5-60% by wt, and (a) comprises at least one electrically conductive or semiconducting metallic particle having essential metallic particles of at least tin metal or a tin alloy. So filler (a) is Sn or its alloy, and other components of (a) are optional. Further, Fillers b and c are optional. Secondly, the content of (A) in the total mixture is 0.5-70 wt%. Thirdly the amount of binder or crosslinking agent is 16-42 wt%; and the mixture further contains other components such as solvent. So after the addition of 42 wt% binder/crosslinker to 60 wt% of (A) in the total mixture and all the other components being optional without a positive recitation of their presence, the concentration of (A) in the final mixture can not be 70 wt% at the high end of the range. Similarly the proposed amendment fails to overcome the rejection of claims under 35 USC 112-II Para.

Further, it does not make the presence of a second component in the fillers of (A) or (a) a positive limitation as argued during the telephonic interview on Feb 24, 2009. The particle size for the filler is not a limitation at least in the independent claim as argued in the interview.

In response to the argument that Claims 155 and 172 were not rejected over the references, they were rejected in rejection-2 over Reising (US 6,715,916) in view of Tsuneta (US 5,213,846) or Matsuda (US 3,904,555); and applicants fail to overcome/argue over this rejection, and the amendment to these claims does not make them patentable over the last office action.

Applicant's argument that the modification of Leon (US 3,562,124) as suggested by the examiner would change the entire invention of Leon which relates primarily to ferro-based electrically conductive materials is noted, and the applicants fail to provide any argument/ evidence in support of this statement. Further, applicant's fillers encompass the fillers of Leon. Leon's Ferroalloys include alloys with metals such as ferromolybdenum and alloys with nonmetals such as ferrophos, and directed to the coatings for metal substrates having corrosion resistance property. Tsuneta is concerned about corrosion resistance of coated steel sheets (Cl-3, Ln 25-29), and so is Matsuda (Title; Abstract) that uses a mixture of Fe and its alloys along with Zn and/or Sn; and the applicants fail to show how a combination of Leon with Tsuneta or Matsuda virtually changes the characteristics of Leon as argued.

For the reasons set forth as above, applicants fail to patentably distinguish their composition over the prior art.

Continuation of 13. Other: The TD overcomes the provisional ODP rejection over SI No. 10/511242.

/KMV/  
March 13, 2009.